

REMARKS

Claims 1, 4-10, 13 and 14 are pending in the instant application. Claims 1, 4-10, 13 and 14 stand rejected. Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, first paragraph for lacking enablement. Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Claims 1, 4-10, 13 and 14 stand rejected under stand rejected under 35 U.S.C. §103 as being unpatentable in view of United States Patent No. 4,994,013 to Suthanthiran et al. Claim 1 has been amended. None of the amendments constitute new matter in contravention of the requirements of 35 U.S.C. §132. Reconsideration is respectfully requested.

Claims 1, 4-10, 13 and 14 stand rejected. Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, first paragraph for lacking enablement. This rejection is respectfully traversed.

The Examiner contends that the specification 'does not reasonably provide enablement for all substrates and iodine containing compounds'. However, Applicants respectfully submit that claim 1 as currently amended does not in fact claim "all substrates and iodine containing compounds". By the amendment to claim 1, each of the claims are restricted to an iodine containing compound containing covalently bonded iodine where the iodine is bonded to at least one other atom which is not a halogen. Support for this amendment is found at page 6, lines 4-7. As claim 1 has been amended to more particularly recite the scope of the present invention, Applicants respectfully

submit that the present claims are enabled. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. This rejection is respectfully traversed.

The Examiner states that “the claims as written read on a multitude of iodine-containing compounds, non-radiation attenuating substrates, and brachytherapy sources”. Applicants respectfully submit that this statement also mischaracterizes the invention. The Examiner’s rejection makes it sound as though the claim is directed to all iodine-containing compounds and all non-radiation attenuating substrates *in addition to* all brachytherapy sources – and thereby concludes that making a thorough search of the prior art would be impossible. However, this is simply not the case. The present invention is directed to a radioactive source for brachytherapy and it is this source which includes a combination of certain iodine compounds adsorbed onto a non-radiation attenuating substrate.

Applicants note that here, as well as in several instances in the prosecution of the instant application, the Examiner has stated that “the use of the product (for use in brachytherapy) is not given patentable weight” and the “the patentability of a product is based upon the components of the product, not the intended use for the product”. The Examiner offers no support for these assertions and Applicant finds these unsupported assertions to be contrary to legal precedents. The Court of Appeals for the Federal Circuit (CAFC) has stated that:

“A claim preamble has the import that the claim as a whole suggests for it. When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Communications Research Inc. v. Vialink Communications Corp., 55 F.3d 615, 34 U.S.P.Q.2d 1816 (Fed. Cir. 1995).

The CAFC went on further to apply this rule even when the preamble fails to supply an element of the claim:

“A claim preamble ‘may entirely fail to supply a necessary element in a combination, yet it may so affect the enumerated elements as to give life and meaning and vitality to them, as they appear in the combination’ Id.

The CAFC’s reasoning is also fully supported by earlier Court of Claims and Patent Appeals precedent that noted “All elements of a combination can be claimed in terms of what they do as well as in terms of what they are. In re Fuetterer, 319 F.2d 259, 138 U.S.P.Q. 217, 222 (C.C.P.A. 1963).

Thus Applicants submit that the Examiner’s unsupported assertion that the use of the product is not to be given patentable weight is contrary to established law, and that Applicants’ characterization of the invention in claim 1 is entirely proper and fully defined in accordance with 35 U.S.C. §112, second paragraph.

Furthermore, the Examiner objects to claim 13 for reading on the “treatment of any possible condition, which is responsive to radiation therapy. (emphasis Examiner’s). Applicants submit that claim 13 is fully proper according to 35 U.S.C. §112, second paragraph. Applicants submit that by limiting the method of treatment to a condition which is responsive to radiation therapy, that the claim is well defined. The Examiner’s emphasis on “any possible condition” in the cited excerpt from the rejection chooses to ignore the limitation that the condition must be responsive to radiation therapy. As the

Applicants have defined within the claim the conditions which are included within the claim scope, it is incorrect to state that the claim is directed to "any possible condition" as the Examiner does in ending further inquiry. As claim 13 fully defines the conditions to which it applies, it is respectfully submitted that such claim structure is fully within the bounds of 35 U.S.C. §112, second paragraph.

As the Examiner's objections to both claims 1 and 13 have been traversed, Applicants respectfully request that the rejection under U.S.C. §112, second paragraph be withdrawn. Reconsideration is respectfully requested.

Claims 1, 4-10, 13 and 14 stand rejected under stand rejected under 35 U.S.C. §103 as being unpatentable in view of United States Patent No. 4,994,013 to Suthanthiran et al. This rejection is respectfully traversed.

In maintaining the rejection the Examiner again states that for a product "patentability is based upon the components of the product, not what each component does (i.e., bind to a surface)". Applicants respectfully note once again that the Examiner has provided no citation as support for this assertion which is contradictory to the hereinabove cited case law.

The present invention is directed a radioactive source for brachytherapy which includes a radioactive isotope of iodine adsorbed onto a non-radiation attenuating substrate.

Suthanthiran discloses a metallic X-ray detectable marker rod coated with a radioactive-absorbing material in a binder into which a radioactive material is absorbed.

Suthanthiran only discloses that the radioactive material is absorbed by radioactive-absorbing material used to coat the substrate/rod. Suthanthiran fails to disclose, teach, or suggest that the radioactive material is adsorbed onto a substrate as is claimed by the present invention. Applicants further submit that as Suthanthiran requires its marker rod be coated with a radioactive-absorbing material, to suggest that the radioactive-absorbing material was not necessary would require impermissibly ignoring the specific teachings of the reference. Applicants respectfully submit that Suthanthiran provides no motivation for adsorbing a radioisotope to the surface of a substrate itself. Therefore, as Suthanthiran fails to disclose teach or suggest a radioactive material adsorbed on the surface of a non-radiation attenuating substrate, Applicants respectfully submit that the present invention is patentably distinct thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant invention, including claims 1, 4-10, 13 and 14, is patentably distinct over the prior art. Favorable action thereon is respectfully requested.

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Reply to Office action of November 30, 2004

Any questions with respect to the foregoing may be directed to Applicants'
undersigned counsel at the telephone number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Chisholm', written over a horizontal line.

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